

## **REMARKS**

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. §1.112, pursuant to and consistent with 37 C.F.R. §1.114 are respectfully requested.

Claims 1-10, 12, 22, 26, 40, 42-44, 46, 50, 53-54, 56, 58 and 63-134 are pending in the application. Of these, claims 1-10, 12, 40, 43, 44, 46, 50, 70-84, 98, 99, 104-105, 111-114 and 123-126 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 22, 26, 42, 53-54, 56, 58, 63-69, 85-87, 100-103 and 106-110, 115-122 and 127-134 are under consideration and stand rejected.

Simply in order to reduce the number of issues upon appeal, claims 70-97, 104-108, 110 and 123-134 have been canceled without prejudice or disclaimer of the subject matter described therein. No claims have been amended.

The amendments do not add any new matter nor do they raise any new issue. Applicants reserve their right to file a continuation or divisional application directed to any subject matter which may have been canceled by the current amendment.

### **Claim rejections- 35 USC §112**

Claims 22, 26, 42, 53-54, 56, 58, 63-69, 85-87, 100-103, 106-110, 115-122 and 127-134 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Simply in order to reduce the number of issues upon appeal, claims 70-97, 104-108, 110 and 123-134 have been canceled without prejudice or disclaimer of the subject matter described therein. Thus, the rejection of claims 85-87, 100-103, 106-108, 110, and 127-134 is moot. Applicants' claims having been twice rejected, Applicants intend to appeal the rejection of claims 22, 26, 42, 53-54, 56, 58, 63-69, 109, and

115-122 to the Board of Patent Appeals and Interferences. A Notice of Appeal is submitted concurrently herewith.

Applicants maintain their previously stated position as supported by the declarations of Drs. Dennis, De Block, Schoffield and Metzloff that a person of ordinary skill in the art would have recognized from the application as filed that the inventors were in possession of the invention as currently claimed.

**Claim rejections- 35 USC §103**

Claims 22, 26, 42, 53-54, 56, 58, 63-69, 85-87, 100-103, 106-110, 115-122, and 127-134 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Flavell, Metzloff et al. and Stam et al., the combination in view of Brown et al. Luskey et al.

Claims 22, 26, 42, 53-54, 56, 58, 63-69, 85-87, 100-103 and 106-108 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fire et al. in view of Brown et al., Luskey et al. and Schiedner et al., the combination in view of Baracchini et al.

Simply in order to reduce the number of issues upon appeal, claims 70-97, 104-108, 110 and 123-134 have been canceled without prejudice or disclaimer of the subject matter described therein. Thus, the rejections of claims 85-87, 100-103, 106-108, 110, and 127-134 are moot.

Applicants maintain that for the reasons set forth in the previous responses, and as supported by the declaration by Dr Michael Metzloff, the currently claimed invention would not have been obvious over Flavell, Metzloff et al. and Stam et al., the combination in view of Brown et al. and Luskey et al. Applicants also maintain all the arguments made in previous responses concerning the objective non-obviousness of the claimed invention demonstrated by the surprising enhancement in the efficiency of gene silencing efficiency by

inclusion of an intron within the expression constructs for gene silencing. The objective non-obviousness is further demonstrated by the widespread use of the claimed invention following its disclosure.

Furthermore, Applicants maintain that they have provided proof of actual reduction to practice of the claimed invention prior to December 23, 1997, the priority date of the Fire patent USPN 6,506,559, effectively removing this document as prior art. The Examiner has not provided any explanation as to why the declaration has been disregarded or deemed not appropriate.

Applicants' claims having been twice rejected, Applicants intend to appeal the rejection of claims 22, 26, 42, 53-54, 56, 58, 63-69, 109, and 115-122 to the Board of Patent Appeals and Interferences. A Notice of Appeal is submitted concurrently herewith.

### **Provisional Double Patenting Rejection**

Claims 22, 26, 42, 53, 54, 56, 58, 63-69, 85-97, 100-103, 106-110, 115-122, 127-134 have been provisionally rejected under the doctrine of obviousness type double patenting over pending claims 22-29, 35-38 of U.S. Patent Application No. 11/841,737. Applicants note that claims 22-29 have been canceled in U.S. Patent Application No. 11/847,737 and claims 70-97, 104-108, 110 and 123-134 have been canceled without prejudice or disclaimer. in this application. Thus, the provisional rejection of at least claims 85-97, 100-103, 106-108, 110, and 127-134 is moot.

The present claims in this application recite features, such as the inclusion of an intron in the construct, that are not recited in claims 35-38 of U.S. Patent Application No. 11/841,737 and that have been demonstrated to be objectively non-obvious. Moreover, Applicants note that the pending claims of U.S. Patent Application No. 11/841,737 recite

features that would not be obvious in view of the present claims. The Examiner has not presented a detailed explanation of the differences between the claims so as to provide a rationale as to why the claims as a whole would have been obvious. Thus, the Office Action does not properly set forth a prima facie case of obviousness.

Furthermore, the present application was filed prior to U.S. Patent Application No. 11/841,737. Therefore it would be appropriate for the Office to withdraw the provisional rejection and allow the present application to issue in any case. However, for the reasons noted above, it is applicants position that the claims of U.S. Patent Application No. 11/841,737 do not conflict with the present claims of this application.

**Rejoinder of process claims 1-10, 12, 40, 43, 44, 46, 50, 70-84, 98, 99, 104-105,**

**111-114 and 123-126**

The withdrawn process claims 1-10, 12, 40, 43, 44, 46, 50, 98, 99 and 111-114 include all the limitations of the product claims under consideration. Accordingly, Applicant will request that the restriction between withdrawn process claims 1-10, 12, 40, 43, 44, 46, 50, 98, 99, and 111-114 and product claims 22, 26, 42, 53-54, 56, 58, 63-69, 100-103, 109 and 115-122 be withdrawn in the event that the product claims are deemed allowable in accordance with 37 CFR 1.104.

**Conclusion**

For the reasons set forth above, Applicants maintain that a notice of allowance is next in order. Applicants claims having been twice rejected, Applicants submit herewith a Notice of Appeal.

In the event there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned concerning such questions so that the prosecution of this application may be expedited.

The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

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